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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/751,125	01/03/2004	Linggawati Tanamal	4001-0007 (ZM0515)	1756
43232	7590	10/04/2004		EXAMINER
ZIMMER TECHNOLOGY - ROBERTS INDIANO, VAUGHN & ROBERTS 1 NORTH PENNSYLVANIA AVENUE #850 INDIANAPOLIS, IN 46204			COMSTOCK, DAVID C	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/751,125	TANAMAL ET AL.
<b>Examiner</b>	<b>Art Unit</b>	
David Comstock	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-16 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 03 January 2004 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 03 January 2004

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8, 10-13, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilhelmy (5,722,977; cited by Applicant).

Wilhelmy discloses an osteotome 7 comprising a head portion 36 including a first planar surface 37 and a second planar surface, e.g. 39, extending obtusely, i.e. not sharply, therefrom (see Fig. 7). A bone cutter 38 defines a single contiguous sharp edge and extends perpendicularly from the first planar surface along the cutting edge of the second planar surface. An anvil 44 is included in the head portion. An elongated rod portion 48 extends away from the first and second surfaces and includes a graspable extent, i.e. a handle. An anvil 49 is coupled to the handle. A third planar surface 43 extends obtusely, again, i.e., not sharply, from the second planar surface. The surfaces extend from each other at about 95 degrees, i.e. 90 degrees is considered to be within the indeterminate range “about 95 degrees.” The surfaces appear to be smooth.

Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Burkinshaw et al. (5,405,349).

Burkinshaw et al. disclose an osteotome 96 including means (i.e. the planar surface 94) to guide a cutter 116 relative to a bone surface and means 98,100,102 coupled to the guiding means for receiving an impact force (see Fig. 6). The guide means includes a generally mogul-shaped (i.e. a circular protrusion) protuberance 128 extending from the planar guide surface.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6, 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willhelmy (5,722,977; cited by Applicant) in view of Urbahns et al. (6,264,657; cited by Applicant).

Willhelmy discloses the claimed invention except for the protuberance on the surface. Urbahns et al. disclose an osteotome 10 comprising a protrusion at the end of the surface to provide additional strength and rigidity to the device (see Figure A, below). It would have been obvious to provide a protrusion on the osteotome of Willhelmy in view of Urbahns et al., in order to provide additional strength to the surfaces and increase the rigidity of the device.

Protrusion reinforcing the blade

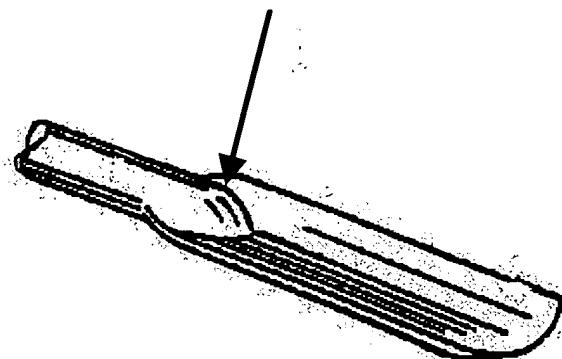


Figure A (corresponds to the rejection, above)

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Willhelmy (5,722,977; cited by Applicant).

Willhelmy discloses the claimed invention except for the angle between the second and the first and the third and the second surfaces of about 135 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form these angles to be about 135 degrees (for example to provide a trapezoidal cross-section to accommodate individual patient anatomy), or to form them to be any of numerous other angles that connect the four surfaces, since it has been

held that where the general conditions of a claim are disclosed in the prior art, i.e. an osteotome having surfaces separated by some given angle, discovering the optimum or workable ranges of the same involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

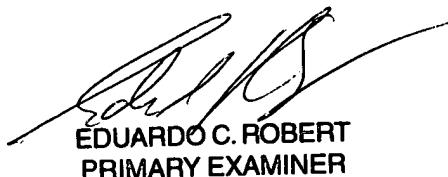
***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D. Comstock  
30 September 2004



EDUARDO C. ROBERT  
PRIMARY EXAMINER